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EXAMINER

GRANT II, JEROME

ART UNIT PAPER NUMBER

2626

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/470,938

Applicant(s)

MCINTYRE ET AL.

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09-14-04.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received. JEROME GRANT II  
PATENT EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

Detailed Action

1. In claim 1, replace "comprising;" with "comprising:"
2. The following is a quotation of the appropriate paragraphs of 35 U. S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371 C of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S. C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U. S. C. 122(b). Therefore, this application is examined under 35 U. S. C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S. C. 102(e)). Claims 1, 3-12 and 14-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Watanabe.

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With respect to claim 1, Watanabe teaches a kit (substantially shown by figure 1) for organizing a plurality of images which are provided to a customer (who is at anyone of household 1; office 1; minilab 3, special lab 4) comprising: an image retaining device (scanner 7 for generating thumbnail images, see paragraph 14) for capturing images, the retaining device has a unique ID (see paragraph 45) which has been forwarded to a database (18) of a network(5); a registration card (conventional paper album/photo album with ID) for using to access the provider for registering said image retaining device to a customer (see paragraphs 67 and 70) and a computer software program such that when loaded on a computer will allow the consumer to accomplish certain operations at the network provider, see computer 6 and paragraph 44.

With respect to claims 3 and 15, Watanabe teaches information from Internet 5 which represents the photo image goods and services.

With respect to claim 4, see paragraph 41. With respect to claims 5 and 18, see paragraph 51 and 67.

With respect to claims 6 and 19, see paragraph 46 where the image processing is the changing of the image content.

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With respect to claims 7 and 20, Watanabe teaches wherein the plurality of image retaining devices (thumbnail) images are provided in a single package (photo image album).

With respect to claims 8, 17 and 21 see the film 13 inside of the retaining device (camera).

With respect to claims 9 and 22, see the film 13 with ID information on the film cartridge. With respect to claim 10, Watanabe teaches the film is part of a cartridge 13 of a single package (see paragraph 39).

With respect to claim 11, Watanabe teaches a plurality of stickers (header information with ID's attached) see figure 64.

With respect to claim 12, the header information is the means for sticking ID with image content which has been read by scanner 7.

With respect to claim 14, Watanabe teaches a registration card (large capacity hard disc or the like and the name of the image file with ID), see paragraph 14 and col. 3, lines 17-22. Watanabe teaches an image retaining device (electronic album containing images a person wishes to share over a network, see col. S, lines 18-26). Watanabe suggest that

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the registration occurs prior to the network photoservice, see para. 14 for the reason that the name of the file must be determined including the ID information before the images are shared over the network. Watanabe teaches a customer views the films according to paragraphs 67 and 70, and a computer software program such that when loaded on a computer will allow the consumer to accomplish certain operations at the network provider, see computer 6 and paragraph 44.

With respect to claim 16, this limitations is addressed by paragraph 44.

With respect to claim 23, Watanabe teaches -the kit, as shown by figure 5, for organizing plural images comprising: an image storage device (database 18) for storing of images, said image storage device having a unique ID (according to paragraph 45) which has been forwarded to a database of a network photo service provider wherein said unique ID is used by said network provider (any of stations 3 or 4); the unique ID of a customer, which is associated with the images, is stored in the storage device, as explained in paragraph 14; moreover, the computer 6 with software applications therein perform operations of the images stored in the storage medium as set forth in paragraph 44.

2. The following is a quotation of 35 U. S. C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Watanabe in view of the Well Known Prior Art. (Official Notice).

While Watanabe teaches all of the subject matter upon which the claim depends, including the use of a computer for providing the program to facilitate the kit, it is not clear if the program is stored in a specific memory source called a CD. It appears that the program is stored in a ROM of the Computer 6.

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The examiner submits that CDS and CD RONI are interchangeable mediums for storing software programs for use on computer applications. Therefore, the use of a CD or other portable storage medium, as opposed to a ROM, would have been obvious to one of ordinary skill in the art of software storage. It would have been obvious to replace the storage medium for storing the software program with a CD type storage means for the purpose of storing a software program.

**3. Claims Objected**

Claim 13 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



4. **Examiner's Remarks**

At page 8 of Applicant's Remarks states that Watanabe does not teach the image retaining device registration card or computer software program according to claim 1. An image retaining device is the (scanner 7 for retaining images ) conversely image data base 17 could also be an image retaining means.

The registration card is a conventional paper album with an ID. The computer software is suggested by the plug-in 22 such as Netscape Navigator.

With respect to applicant's arguments to claim 14, Applicant argues that there is no computer software program to allow the customer to interact with the network. This software program is suggested by the plug-in 22 such as Netscape Navigator.

With respect to claim 23, Applicant argues that the unique ID is associated with an image retaining device and that Watanabe does not teach this. The unique ID of the image data storage device refers to the register ID for registering digital images on a film, see paragraph 3 and 47.

### Examiner's Remarks

With respect to applicant's remarks at the third paragraph of page 6, the applicant avers that the present invention is a kit that is provided to a customer. The examiner contends that there is no language in claim 1 which suggests what applicant is arguing. There is no language in claim 1 which states that a kit is provided to a customer. If this is a novel feature, applicant is encouraged to incorporate it in the language of the claim.

At the bottom of page 6, applicant contends that Watanabe does not teach a registration card nor the software portion of the kit. The examiner contends that both statements are not accurate. With regard to the first, Watanabe teaches a conventional paper album/photo album with an ID. The examiner relied upon this reading of Watanabe however, the applicant has not shown why the album with the ID thereon codes does not anticipate nor makes obvious the claimed invention. Applicant argues that because the registration card is not part of the kit, it cannot be delivered to a customer. The examiner contends that the album is deliverable to a customer because it contains the images that are to be viewed, selected and processed. With regard to the second point, applicant contends that Watanabe does not address a software program. A software program is at least suggested by paragraph 44 yet applicant has not recited in the arguments why this section of Watanabe, including the computer 6, does

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not provide a program for allowing a user to perform certain operations. The examiner contends that this language is suggested by Watanabe and anticipates the claim.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

J. Grant II

Jan. 7, 2005